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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,280

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Yoshio Nakamura

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EXAMINER

PATEL, DHIRUBHAI R

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,280

Applicant(s)

NAKAMURA, YOSHIO

Examiner

DHIRU R. PATEL

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0305.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the grommet includes a first resin- molded division member, a second resin-molded division member and a joining portion recited in claim 1 must be shown or the feature(s) canceled from the claim(s). The examiner suggest showing reference number for a first resin- molded division member, a second resin-molded division member and a joining portion. A proposed drawing correction or corrected drawings are required in reply to the office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. No new matter should be entered.

Applicant is responsible for showing reference number for claimed invention.

2. Applicant is required to submit a proposed drawing correction in reply to this office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note: inventor is responsible to show each claimed element on the drawings.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claims 1 and 9 are not adequately supported by the specification, such as includes a first resin- molded division member, a second resin-molded division member and a joining portion and a retaining member.

Please note that the claims 1 and 9 must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see MPEP 608.01 (d)(1).

Applicant to encourage to review the remaining claims and to make sure that all claims meet the requirement of meet MPEP 608.01 (d)(1) as mentioned above.

Claim Rejections - 35 USC § 112

5. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a grommet (for claims 1 and 4), the specification does not reasonably provide enablement for the grommet includes a joining portion which prevents the elastic seal member from being separated from the one resin-molded division member (for claim 1), and a waterproof rib (for claim 4). The specification does not enable any person skilled in the art to which it pertains, or with

which it is most nearly connected, to make or assemble the invention commensurate in scope with the claims. The specification doesn't reasonably disclose the claimed subject matter of claims 1, 4, and therefore the subject matter of claims 1 and 4 are not enabled by the disclosure of the invention. The applicant is required to cancel the claims 1-5 or provide a reasonable explanation of why they feel the specification supports the subject matter as disclosed in claims 1-5 **that includes specification by page and line number, and to the drawings reference characters in the disclosure.**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 –3, 6-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 lines 11-12, " the one resin-molded division member" is unclear and confusing because it is not clear that the one division member is a first resin member or a second resin member as claimed in claim1?.

In claim 2 lines 2-4, " the one division member " is confusing and unclear because it is not clear that a first division member or a second division member as claimed in claim 1.

In claim 3 line 5, " the elongated member" lacks antecedent basis.

In claim 6 line 9, " the second retaining member " lacks antecedent basis.

In claim 9 lines 7-8, " a retaining member which retains the first and second division members" is confusing because it is not shown on the drawings as well as it is not clear that a single retaining member retains the first and second division members.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 4-5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sato et al (6,768,054).

Sato disclose :

Regarding claim 4, a grommet 21(see fig 2, column 5 lines 29-30) for the passage of a wire harness therethrough and for mounting on a waterproof box 1 (see fig 1, column 1 lines 5-4, column3 line 62) including a box body 3 (see fig 2, column 4 lines 10-35) and a lid member 4 (see fig 2, column 4 lines 15-20) for fitting on the box body, the box body having a notch opening portion 22 (see fig 2), the grommet comprising; a waterproof rib 30, 32 (see fig 1 and entire column 7) abutting against a peripheral wall portion of an upper edge portion of the box body which defines opposite ends of the notch opening portion (see fig 1), wherein when the lid member is fitted on the box body, the waterproof rib is pressed toward the inside of the box body(see fig 3).

Regarding claim 5, wherein the waterproof rib extends in a direction of mounting of the wire harness onto the grommet (see fig 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-3 as best understood, are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Pulaski (6,218,625).

Pulaski discloses:

Regarding claim 1, a grommet 10 (see fig 1, column 2 lines 24-50) for holding an elongated member 12 (see fig 1),
comprising:

Art Unit: 2831

a first resin-molded division member 16 ; and a second resin-molded division member 16 for mounting on the first resin-molded division member (see fig 1), wherein an elastic seal member 22, including an elastomer, is integrally formed on at least one of the first and second resin-molded division members by insert molding (see fig 1, column 2 lines 38-50); and wherein the grommet includes a joining portion 30 which prevents the elastic seal member from being separated from the one resin-molded division member (see fig 1, column 3 lines 10-20), but fails to disclose each of the first and second resin-molded division members includes a polyamide resin. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Pulaski with each of the first and second resin-molded division members includes a polyamide resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claims 2-3, considering the 112 first and second paragraphs, claims 2-3 are included in this rejection as best understood.

Allowable Subject Matter

10. Claim 6 and 9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

11. Claims 7-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 2831

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for the indication of the allowability of claims 6-9 are the inclusion therein, in combination as currently claimed, of the limitation of a retaining member, retaining the first division member to the second division member so that opposed portions of the first and second division members are spaced from each other; and a fixing member, retaining the first division member to a mounting member (for claims 6-8), and wherein when the fixing member retain the first division member to the mounting member, the first and second division members are fixed in an integrally-connected manner to the mounting member so that the opposed portions of the first and second division members are held in intimate contact with each other (for claim 9).

The previously listed limitation is neither disclosed nor taught by the prior art of record, alone or in combination.

Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is 571-272-1983.

The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2831

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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Dhiru Patel
Primary Examiner
Group Art Unit 2831
3/3/2005


DHIRU R. PATEL
PRIMARY EXAMINER
8/3/05